

REMARKS

I. Status of the claims

By this Amendment, Applicant cancels claims 25 and 26, without prejudice or disclaimer of the subject matter therein, and amends claims 20, 22-24, and 27. Claims 1-24 and 27 are pending, with claims 1-19 withdrawn and claims 20-24 and 27 under examination.

In the Office Action of April 15, 2004,¹ claims 20-27 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,085,079 to *Tabeta* (“*Tabeta*”). In addition, the Examiner requested affirmation of the telephonic election made on March 18, 2004, in response to the Examiner’s requirement for restriction. Applicant affirms the election, made without traverse, of Group III (claims 20-27) for examination, and addresses the rejection of claims 20-27 below.

II. Rejection of claims 20-27

The rejection of claims 25 and 26 is rendered moot by the cancellation of those claims. Further, Applicant traverses the rejection of claims 20-24 and 27 under 35 U.S.C. § 102(e) because *Tabeta* does not anticipate the claims.

In order to properly anticipate Applicant’s claimed invention under 35 U.S.C. § 102(e), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the...claim[s].” See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.”

M.P.E.P. § 2131 (8th Ed. 2001), p. 2100-69.

Independent claim 20, as currently presented, recites a combination including:

a storage device storing response messages for replying to calls
and telephone numbers in association; and

a second communication control unit obtaining a response message
corresponding to the telephone number in the response message
request from the storage device

Tabeta does not teach or suggest at least “a storage device storing response messages for replying to calls and telephone numbers in association,” as recited in claim 20. As the Examiner noted (OA at 4), *Tabeta* describes a “data memory 311 for storing voice data” (col. 7, lines 24-25). This data memory, however, does not teach or suggest the claimed “storage device.” As *Tabeta* explains, “[u]pon detection of a . . . response signal [indicating that a call is answered], the voice storage device starts a storage operation of voice data at a corresponding one of different storage positions in units of mobile terminals” (Abstract). *Tabeta*’s does not teach or suggest “a storage device storing response messages for replying to calls and telephone numbers in association” as recited in claim 20. Instead, as noted above, *Tabeta*’s system stores “voice data,” which corresponds to user speech, in units of mobile terminals. *Tabeta*’s “voice data” does not constitute the claimed “response messages.” For at least these reasons, *Tabeta* fails to disclose the “storage device” recited in claim 20.

Tabeta further fails to disclose or suggest “a second communication control unit obtaining a response message corresponding to the telephone number in the response message request from the storage device,” as claimed. Because *Tabeta* does not teach or suggest each and every feature of claim 20, as a matter of law, it cannot anticipate this claim.

Independent claims 23, although of different scope, includes features related to those of claim 20 noted above. In particular, claim 23, as currently presented, recites *inter alia*:

a second portable unit . . . [that] receives [a] . . . response message request . . . causing said second portable unit to obtain a response message for replying to the call corresponding to the telephone number in the response message request from a storage device in which response messages for replying to calls and telephone numbers are stored in association

Similar to claim 20, independent claim 27, as currently presented, recites in part:

a storage device storing response messages for replying to calls and telephone numbers in association; and

a communication control unit . . . obtaining a response message corresponding to the telephone number in the received response message request from the storage device

For at least the reasons presented above in connection with claim 20, *Tabeta* does not anticipate claims 23 and 27. Because *Tabeta* does not anticipate claims 20, 23, and 27, the rejection of these claims under 35 U.S.C. §102(e) should be withdrawn. The rejection of claims 21, 22 and 24 should be withdrawn as well, at least because of the respective dependence of those claims from base claims 20 and 23. Applicant thus requests withdrawal of the rejection of claims 20-24 and 27 under 35 U.S.C. § 102(e) and the timely allowance of these pending claims.

III. Conclusion


The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicant requests the Examiner's reconsideration of the application in view of the remarks presented herein, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 15, 2004

By: 
Frank A. Italiano
Reg. No. 53,056